

**REMARKS**

Claims 1-12 and 14– 38 are pending in the application. Claims 1, 6, 7, 9, 14, 16, 21, 22, and 28 are amended. Claim 13 is cancelled. Applicant respectfully request reconsideration and withdrawal of the rejections in light of the remarks contained herein. No new matter has been added.

**I. Allowable Subject Matter**

Claims 13-15, 22 and 33 have been indicated as containing allowable subject matter. Applicant thanks Examiner for this indication.

**II. Rejections Under 35 U.S.C. § 112**

Claims 1 -- 38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Antecedent basis issues have been corrected and Applicant has made efforts to address Examiner's other concerns.

Applicant thanks Examiner for providing an extremely thorough examination of the present application. This type of examination is always helpful in progressing prosecution in an expedited manner. However, it seems that in some cases, Examiner is simply pointing out the inherent ambiguities of the English language. For example, Examiner takes issue with the use of the term “proximal/proximate end” in the claims stating that it could be argued that a cable end of a probe is proximate to a processing system. However, Examiner's own assertion gives proper context to the location of a proximate end when qualifying it as proximal *to a processing system*. In the context of the claim language, Applicant submits it is clear which is the proximal end *of the image probe*. Further, when read in light of the specification, it is abundantly clear what the term proximal/proximate end means. Applicant sees no better way to phrase the claim language, and respectfully solicits suggestions from Examiner on ways to correct this issue in the event that the rejection is maintained.

Similarly, Examiner takes issue with the term “longitudinal” in claims 9 and 16. Applicant respectfully submits that in the given context of the claim language and in light of the specification the term longitudinal is definite. For example, claim 9 recites that the guide

has a longitudinal seating area for positioning a rod therein. It is clear that the rod will go in the longitudinal area, and it is clear that the rod will be directed to a patient's body. This should give proper definition to the claim. Applicant sees no better way to phrase the claim language, and respectfully solicits suggestions from Examiner on ways to correct this issue in the event that the rejection is maintained. Further, even if Examiner wants to apply obscure definitions or hypotheticals, Applicant sees no reason why the claim would not cover such hypothetical situations. Applicant submits that breadth does not indicate indefiniteness.

Examiner takes issue with the term "over" in claims 6 and 7. Applicant also believes that these claims are definite in context and in light of the specification. However, for the sake of advancing prosecution, Applicant has amended these claims in an attempt to further clarify their meaning.

In light of the above, Applicant submits that the rejections under 35 U.S.C. §112 are overcome. Hence, Applicant respectfully requests withdrawal of said rejections.

### **III. Rejections Under 35 U.S.C. § 102**

Claims 1, 4 – 5, and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,763,662 (filed May 27, 1986, issued August 16, 1988) to Yokoi (hereinafter "*Yokoi*"). Examiner states that *Yokoi* is applied in response to an interpretation that can be asserted due to clarity issues raised in the present §112 rejections. Applicant submits that the §102 rejections based on *Yokoi* are now moot.

Claims 1 – 10, and 24 – 26 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,924,992 (filed November 26, 1997, issued July 20, 1999) to Park et al. (hereinafter "*Park*"). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," *Verdegaal Bros. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Because the *Park* reference fails to teach each and every claim element in the present application, Applicant respectfully submits that the above rejections are improper.

Claim 1 has been amended to recite "a bracket configured to attach a medical device support to the body of an imaging probe, said bracket adapted for accepting, one at a time, a

plurality of medical device supports, each having either a different angle of attack or accepting a different gauge corresponding to a medical device.” *Park* does not teach at least the above cited limitations of currently amended claim 1. Hence rejection of claim 1 over *Park* is now moot, and Applicant respectfully requests withdrawal of the rejection.

Claim 9 has been amended to include the limitations of dependent claim 13 which Examiner has indicated as allowable. Hence, Applicant submits claim 9 is allowable.

Claim 24 recites “a slide for traversing said channel, said slide applying controlled clamping force on an accepted elongated medical device.” It is clear that what Examiner interprets as a slide in *Park* is “rotatable around a needle axis” (see *Park* Col. 2 lines 21-22). Hence, *Park* does not teach a slide as recited in claim 24. Examiner appears to recognize this deficiency in *Park* when rejecting claim 10 in the Office Action (see page 5 last paragraph). Further, the rotatable guiding pin in *Park* cannot be interpreted to traverse a channel, as there does not appear to be anything in *Park* that can be construed as a channel. Hence, *Park* does not teach a slide for traversing said channel, said slide applying controlled clamping force on an accepted elongated medical device.

Claims 2-8, 10, and 25-26 depend from claims 1, 9, and 24 respectively, and thus, inherit the limitations stated therein. As a result dependent claims are not anticipated by *Park* for at least the reasons stated above. Further, the dependent claims teach limitations that are not shown in *Park*. For example, claim 10 recites “wherein said latch is positioned perpendicular to said seating area and wherein said latch slides across said seating area.” As stated above, *Park* utilizes a rotatable guiding pin to capture a needle. Hence *Park* does not teach these limitations in claim 10.

#### **IV. Rejections Under 35 U.S.C. § 103**

Claims 6, 10, and 24 – 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Park* and U.S. Patent 7,087,024 (filed June 6, 2003, issued August 8, 2006) to Pruter (hereinafter “*Pruter*”). Claims 11, 12, 27, 28, 31, and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Park* and U.S. Patent 5,076,279 (filed July 17, 1990, issued December 31, 1991) to Arenson et al. (hereinafter “*Arenson*”). Claims 16 – 21, 23, and 29 – 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Arenson* and U.S. Patent

4,346,717 (filed August 18, 1980, issued August 31, 1982) to Haerten (hereinafter “*Haerten*”). Claims 35-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Arenson* and U.S. Patent 5,758,650 (filed September 30, 1996, issued June 2, 1998) to Miller et al. (hereinafter “*Miller*”).

To render a claim unpatentable under 35 U.S.C. § 103, all the claim limitations must be taught or suggested by the prior art, M.P.E.P. § 2143.03. The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness, M.P.E.P. § 2142; *In re Peehs*, 612 F.2d 1287, 204 USPQ 835, 837 (CCPA 1980). Applicant asserts that the rejections of record do not show that all claim limitations are met by the applied art, and thus a *prima facie* showing of obviousness under 35 U.S.C. § 103 has not been made.

#### **A. Park and Pruter Rejections**

Claims 6, 10, and 24 – 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Park* in view of *Pruter*. As shown above, *Park* does not teach multiple limitations found in independent claims 1, 9, and 24. Thus, the combination of *Park* and *Pruter*, even if proper, does not render claims 6, 10, and 24-26 obvious.

Examiner states that in the event that the latch mechanism shown in *Park* can not be considered as “sliding” then it would have been obvious to use the slide in *Pruter* for needle confinement purposes (see Office Action Page 5 last paragraph). This statement, even if true, does not create a combination which teaches claimed elements of the present invention. For example claim 24 recites “a slide for traversing said channel, said slide applying controlled clamping force.” In *Pruter*, the needle stop 120 slides until it contacts the needle 101. The needle stop is prevented from sliding across (i.e. traversing) the needle gap 130. Hence, nothing in *Pruter* can be said to teach “a slide for traversing said channel, said slide applying controlled clamping force.”

Similar arguments apply to the dependent claims which are rejected. For example, claim 6 recites “a latch for sliding over a surface of said medical device.” In *Pruter*, the needle stop is prevented from sliding completely across the channel, which is why needle gap 130 is created. It is also clear that the needle stop in *Pruter* does not slide over a surface of

the medical device. Accordingly, *Pruter* fails to teach a latch for sliding over a surface of said medical device and Applicant submits that the current rejection should be withdrawn.

#### **B. Park and Arenson Rejections**

Claims 11, 12, 27, 28, 31, and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Park* in view of *Arenson*. Independent claim 28 recites “releasably connecting a bracket to the proximal end of said probe” and “releasably connecting a guide to a connected bracket, so that the longitudinal axis of said guide falls along the longitudinal axis of said probe.” Examiner asserts that it would have been obvious to use a bracket and pivot point 40-43 to mate or separate a guide and probe using the teachings of *Arenson*. However, Applicant respectfully submits using *Arenson* as applied to the claims would not provide a functional bracket/guide configuration.

*Arenson* uses spring means 40 to hold the guide 10 in place against a transducer. The spring tension is created as a result of the configuration of spring means 40 within guide 10 (see Figure 1). In other words, spring means 40 is useless without guide 10 because there would be nothing to provide force on spring means 40 in order to keep it connected to the transducer. Hence the spring means in *Arenson* cannot be considered a bracket. Further, even if the spring means were a bracket, it could not be considered a bracket connected to the proximal end of a probe as required by claim 28. It is noted that the language of claim 28 recites that a guide is connected to the *connected* bracket. As the spring means in *Arenson* can not be independently connected, it cannot be properly applied to the above recited claim language. For at least this reason, the rejection on claim 28 should be withdrawn.

Claims 31 and 34 depend either directly or indirectly on claim 28 and are therefore allowable for at least the same reasons as set forth for independent claim 28. Further, many of the rejections on the dependent claims have similar deficiencies. For example, claim 11 recites “a bracket for mating to said probe at said proximal end of said probe, and at least one pivot point for allowing said guide to release from said bracket.” If the *Arenson* reference was applied to this claim, once the guide was released from the spring means, the spring means would simply fall off of the probe, thereby rendering the combination not suitable for the purposes of the present invention.

Likewise, claim 27 recites “a bracket releasably affixed to both said guide and said proximate end of said probe.” As already shown, the spring means in *Arenson* cannot be said to be releasably affixed to both the guide and the probe because once it is separated from the probe, it is rendered useless. In view of the above, it is clear that the spring means in *Arenson* cannot be considered a “bracket” as recited by the claims of the present invention.

#### **C. Arenson and Haerten Rejections**

Claims 16 – 21, 23, and 29 – 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Arenson* in view of *Haerten*. Currently amended claim 16 recites “said clamping controlled at least in part by a latch having a dimension keyed to the diameter of said medical device.” Support for this amendment is found throughout the specification (see e.g. [0030]). Neither *Arenson* or *Haerten* appear to teach the above recited limitation. Further, it appears that the other art of record does not teach this limitation. Hence, Applicant respectfully requests withdrawal of the rejection.

Claims 17-21, 23 and 29-31 depend either directly or indirectly from independent claims 16 and 28 respectively. As a result, claims 17-21, 23 and 29-31 inherit all the limitations from their corresponding independent claims. Thus, the proposed combination, even if proper, does not teach each of the limitations of dependent claims 17-21, 23 and 29-31.

#### **D. Arenson and Miller Rejections**

Claims 35-38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Arenson* in view of *Miller*. Claim 35 recites “positioning a guide support bracket at said proximal end of said probe, said guide support bracket adapted for accepting, one at a time, a plurality of needle guides.” As shown above, the device taught in *Arenson* would be useless if not simultaneously connected to the guide. Hence, *Arenson* does not teach a bracket adapted for accepting, one at a time, a plurality of needle guides.

Claims 36-38 are dependent on claim 35, and are allowable for at least the same reasons. Applicant takes particular issue with Examiner’s rejection of claim 38. Claim 38 recites “removing said needle guide from a plurality of needle guides of like gauge but

having different angles of attacks, said plurality of needle guides being held by a common bond." Examiner asserts that it would be "inherently obvious" to package a set of components together such that they are organized and co-locatable. As inherency is usually a §102 issue, it appears as if Examiner is taking official notice of the limitations in claim 38. If this is the case, the Applicant requests proper documentation pursuant to MPEP §2144.03.

Further, it is readily apparent that such a layout would be untenable if applied to *Miller*. *Miller* utilizes metallic pieces which are preferably made of magnetic material (see abstract). With such a design, placement on a common bond would cause magnetic pieces to be in close proximity, thereby stressing the bond. Further, the weight of such pieces would tend to discourage such a layout. Hence, applicant respectfully submits that the rejection on claim 38 is improper.

#### **V. Conclusion**

In view of the above, Applicants believe the pending application is in condition for allowance and respectfully requests favorable reconsideration.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 65744/P016US/10316060 from which the undersigned is authorized to draw.

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Respectfully submitted,

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